

### **REMARKS**

Claims 1-12, 15-28, and 31-41 were pending in the application. Claims 7-10, 23-26, and 34-39 have been withdrawn from consideration. In this amendment, Claims 15 and 31 have been cancelled, Claims 1, 3-6, 11, 12, 16, 17, 19-22, 27, 28, 32, 33, 40, and 41 have been amended and no new claims have been added. Therefore, Claims 1-12, 16-28, and 32-41 are pending in the application. Claims 7-10, 23-26, and 34-39 have been withdrawn from consideration.

### **The Rejections under 35 U.S.C. § 112**

The Examiner has rejected Claims 1 and 3-6 under 35 U.S.C. 112 as being indefinite. The Examiner noted that the limitation of “adapted to be mounted to a railing” did not positively recite the railing. Applicant has amended Claim 1 to positively recite the railing and its support elements. Claims 3 and 4 have been amended to be consistent in scope with Claim 1. Accordingly, Applicant respectfully requests that the rejection under 35 U.S.C. 112 be withdrawn.

### **The Rejections under 35 U.S.C. § 103**

#### **Claims 1-2, 11-12, 15-16, and 40**

The Examiner has rejected Claims 1-2, 11-12, 15-16, and 40 under 35 U.S.C. 103(a) as being unpatentable over Gilbert (AU-A-52021/96) in view of Reed (U.S. 6,655,083). As Claim 15 has been canceled and its limitations incorporated into Claim 1, Applicant submits that the rejection is now moot with regard to Claim 15. With regard to the other claims, Applicant respectfully traverses the rejection.

Gilbert teaches a plant container that is mounted to a post, or other vertical support. The present invention specifically teaches that the planter receptacle is not mounted to the vertical support. Rather, according to the present invention, the planter receptacle is suspended from a non-vertical support member of a railing. Gilbert does not teach that the plant container is suspended. As noted by the Examiner, Gilbert does not include any hanging means. Reed teaches a garden swing having planters attached to the seating member. Reed does not teach that the garden swing is suspended from a non-vertical support of a railing, or that it has a stabilizing means.

To establish a *prima facie* case of obviousness, there must be some teaching, suggestion, or motivation, either in the references themselves or in a convincing line of reasoning with knowledge generally available to one of ordinary skill in the art, to combine reference teachings. See Manual of Patent Examining Procedure (MPEP) §2144; *Ex parte Clapp*, 227 USPQ 972 (Bd. Pat. App. & Inter. 1985). There is no suggestion to combine the references. Nevertheless, the Examiner asserts that “it would have been obvious” to do so.

As the Examiner is aware, obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 221 U.S.P.Q. 929 (Fed. Cir. 1984). Thus, the Examiner may not use the patent application as a basis for the motivation to combine or modify the prior art to arrive at the claimed invention.

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. ... It is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that “[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q. 2d 1443 (Fed. Cir. 1992) quoting *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q. 2d 1596, 1600 (Fed. Cir. 1988).

In the present case, the Examiner has selected portions from two references to arrive at the present invention, in which, neither of the references supply the motivation for the additional reference as proposed. Rather, the references are relied upon for selected elements, but the desirability of the elements in the combination has not been supplied absent the present application. Since the references do not supply the desirability of the modification, it is respectfully submitted that a *prima facie* case of obviousness has not been established.

Indeed, it does not make sense to combine the references. First, the combination of Gilbert and Reed causes their primary functionality to be diminished or obliterated. The planter receptacle of the present invention is adapted to be suspended from a railing. Gilbert provides a solution to decorate a single vertical element, such as a post. Planters that are stationary in the vertical are appropriate for posts, since integration of post and planter is primarily desirable in

order to provide support for the plant as it grows. The vine of the plant may wrap around the post, or be tied to the post, as the plant grows. The hanging means of the present invention would have no utility with respect to the planter as shown by Gilbert. Furthermore, the swing of Reed would not function if it were hung from a railing or other non-vertical support along the edge of a deck, porch, or patio, as described in the present application. A railing is generally too low to provide a satisfactory height for a swing, and the balusters, pickets, and deck or porch would interfere with the back and forth motion of the swing. Accordingly, the primary functions of Gilbert and Reed causes their very combination to be illogical and abstract, and not at all obvious.

Furthermore, neither Gilbert nor Reed teaches stabilizing means, but rather attachment. Stabilization is featured by the present invention to reduce horizontal motion and prevent the tipping of the planter. Gilbert's planter receptacle is mounted to its post using fasteners (see nail 44 in Figure 8). Stabilization is not needed for Gilbert as it is not contemplated to move freely in a vertical direction along its post or in a horizontal direction away from the post. Reed's planters are affixed to the swing seat, thereby preventing vertical or other adjustment relative thereto. Further, any feature supplemental to Reed intended to reduce horizontal motion or tipping would only diminish or eliminate the operability of the swing.

For these reasons, making the association to combine Gilbert and Reed in order to compare them to Applicant's invention does not make sense. The purposes of Gilbert and Reed are not at all similar to the purpose of the present application. As Gilbert in combination with Reed neither teaches nor suggests the features of the present invention, Claim 1 is patentably distinguished.

Claim 2 depends from Claim 1 and incorporates the same limitations as Claim 1. Thus, Claim 2 is, likewise, patentably distinguished.

As for Claims 11 and 12, the combination of Gilbert and Reed, as cited by the Examiner, does not teach the feature of Applicant's invention. The connecting means recited in Claim 11 is described in the specification as comprising a mechanical system such as S-hook and chain, or stopped cable and retainer, to provide ready vertical adjustment of its planter receptacle. This provides a straightforward solution for accommodating the rapid growth of flowers during a relatively short growing season to improve viewing such flowers with respect to deck/porch and

patio railings. Applicant respectfully submits that Gilbert's "connecting means 52 attached to wall 54" (see Figures 11, 12, and 13) exists to permit the concentric alignment of symmetrical planter parts around its post longitudinally, not to enable vertical adjustment with respect to its post as suggested by Examiner. The planter container taught by Gilbert demonstrates mounting to its post using fasteners (see nail 44 in Figure 8). Such attachment serves to defeat the vertical adjustment functionality afforded by the present invention. Additionally, Reed does not address adjustment, which is so seldom an issue for swings since people grow much more slowly over years and years, unlike the rapid growth that is typical of seasonal flowers.

It is not enough that a reference uses similar terminology to name an element when the elements from different applications have completely different functionality. In the present invention, the connecting means enables the hanging means to be attached to the planter receptacle.

Moreover, the combination of Gilbert and Reed, as cited by the Examiner, does not teach the feature of Applicant's invention whereby the connecting means itself is vertically adjustable to provide for precise leveling of the planter receptacle with respect to the railing or picket fence. This functionality, described in sections [0029] and [0030] of the published application, is separate from, and in addition to, the vertical adjustability of the planter receptacle described immediately above. Neither Gilbert nor Reed teaches this feature. Thus, Claims 11 and 12 are patentably distinguished.

As for Claims 16 and 40, the combination of Gilbert and Reed, as cited by the Examiner, does not teach the feature of Applicant's invention whereby fast and easy height variability is achieved by relying on the interoperability of the hanging means with the connecting means. Neither Gilbert nor Reed teaches any similar functionality. Gilbert teaches a stationary solution (again, see nail 44 in Figure 8). Reed teaches a planter receptacle that is part of the swing seat ("integrally formed with said seating member"), not a receptacle that is movable with respect to the swing seat. While Applicant agrees that the hanging means enables the function of variable height, once again, there is no motivation to add the functionality to Gilbert except based on the Examiner's suggestion. Since the references do not supply the desirability of the modification, it is respectfully submitted that a *prima facie* case of obviousness has not been established. Thus, Claims 16 and 40 are patentably distinguished.

### Claims 3-6

The Examiner has rejected Claims 3-6 under 35 U.S.C. 103(a) as being unpatentable over Gilbert as modified by Reed, and further in view of Tilton (U.S. 6,796,539). Applicant respectfully traverses the rejection.

As described above, the Examiner has selected a portion from a couple of references to arrive at the present invention. None of the references supplies the motivation for the additional references as proposed. Rather, the references are relied upon for selected elements, but the desirability of the elements in the combination has not been supplied absent the present application. Since the references do not supply the desirability of the modification, it is respectfully submitted that a *prima facie* case of obviousness has not been established.

Furthermore, the planter receptacle of the present invention is not mounted to the vertical support member as shown in Tilton. The present invention shows a device that is suspended in place. Moreover, Tilton does not teach stabilizing means, but rather attachment. Stabilizing means is featured by the present invention to reduce horizontal motion and prevent the tipping of the planter, and to specifically avoid fastening the planter to balusters in order to allow vertical adjustment. Tilton's planter receptacle is actually mounted to balusters using a turn-screw mechanism. While its position can be changed with regard to the balusters, it does not present the same functionality as the present invention.

The combination of features recited in Claims 3 and 4 of the present invention enables fast and easy vertical adjustment functionality of its planter receptacle with respect to a railing, and affords an improvement upon the Tilton solution for planter support on railings. The instant method is believed capable of supporting more weight since it attaches to (is suspended from) a railing element that is structurally superior to balusters. Further, the present invention does not risk scratching or damage to balusters. The claimed planter receptacle does not permit the planter to slide to lower or uneven positions on railings, as Tilton might on balusters, particularly if its turn-screw mechanism is bumped or loosened, or, if weight is not evenly distributed in its planter.

Lastly, Tilton's method or technique for mounting the planter involves attachment to a vertical support (baluster(s)). It therefore requires no suspension means (chains or the like). As explained previously, the chains of Reed exist to provide functionality for the swing, not its

planters. Indeed, the swing of Reed could not function if it were attached to a railing. A non-vertical railing or fence support is generally too low to provide a satisfactory height for a swing, and the support members of the railing would interfere with the back and forth motion of the swing.

Therefore, by combining Tilton with Reed, the chains become moot and are useless with respect to Tilton, and the primary functionality of Reed is destroyed, making their combination pointless. Thus, Claims 3-6 are patentably distinguished.

**Claims 17-22, 27-28, 31-33, and 41**

The Examiner has rejected Claims 17-22, 27-28, 31-33, and 41 under 35 U.S.C. 103(a) as being unpatentable over Gilbert in view of Reed and Tilton. As Claim 31 has been canceled and its limitations incorporated into Claim 17, Applicant submits that the rejection is now moot with regard to Claim 31. With regard to the other claims, Applicant respectfully traverses the rejection.

When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to: (A) the claimed invention must be considered as a whole; (B) the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (D) reasonable expectation of success is the standard with which obviousness is determined. *See MPEP § 2141 and Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 220 U.S.P.Q. 182, 187 n.5 (Fed. Cir. 1986).

The Examiner has selected portions from three, unrelated references to arrive at the present invention. None of the references supplies the motivation for the additional references as proposed. Rather, the references are relied upon for selected elements, but the desirability of the elements in the combination has not been supplied absent the present application. Since the references do not supply the desirability of the modification, it is respectfully submitted that a *prima facie* case of obviousness has not been established.

Furthermore, as described above, none of the references describes a stabilizing means that is not attached to the balusters/vertical support members. The present invention describes and claims a planter receptacle that is suspended by a hanging means from the top rail of a railing or fence and that is horizontally stabilized by, but not attached to, the vertical support

members. The combination of elements in the present invention permits the planter receptacle to be easily adjusted in height with regard to the railing. As the combination of references does not disclose all the elements of Claim 17, it is patentably distinguished.

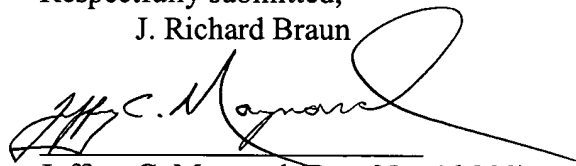
The remaining Claims 18-22, 27-28, 31-33, and 41 depend from Claim 17 and incorporate the same limitations as Claim 17, which as described above, is patentably distinguished from the combination of references. Thus, Claims 18-22, 27-28, 31-33, and 41 are patentably distinguished. Moreover, the same arguments with regard to Claims 2-6, 11-12, 16, and 40 apply to Claims 18-22, 27-28, 32-33, and 41, respectively. Accordingly, Applicant respectfully asserts that all the claims are patentably distinguished.

### **CONCLUSION**

Applicant has made a diligent effort to address the rejections identified by the Examiner and respectfully submits that the outstanding rejections in the Office Action have been overcome. In view of the above amendments and remarks, all pending claims are believed to be patentable, and thus, the case is in condition for allowance. Accordingly, a Notice of Allowability is respectfully requested at the Examiner's earliest convenience. In the event that there is any question concerning this response, or the application in general, Applicant respectfully requests that the Examiner contact Applicant's attorney at the telephone number listed below so that additional changes may be discussed.

Respectfully submitted,  
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Date

  
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